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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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23117	7590	08/30/2006	[REDACTED]	[REDACTED]
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ARLINGTON, VA 22203			ART UNIT	PAPER NUMBER
			2134	

DATE MAILED: 08/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/022,412	MATSUBARA ET AL.	
	Examiner	Art Unit	
	William S. Powers	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 June 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 2 and 4-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 2 and 4-12 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 20 December 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 6/21/2006 have been fully considered but they are not persuasive.
2. As to Applicant's argument that the combined claims fail to teach a recording medium, Applicant is directed to Noguchi column 5, line 41-column 6, line 5 which recites a game cartridge that has a memory unit. In addition, Applicant argues that the deMuro reference does not disclose a recording medium; one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As stated previously, the recording medium is in the Noguchi patent. The limitations added by amendment to claim 2 are addressed below.

For at least the reasons stated above, the 35 USC 103(a) rejection of claims 2, 5 and 6 is maintained.

As to Applicant's argument that the combination of Noguchi, Hagiwara, deMuro and Schneier fails to teach the claim limitations of claim 4 and therefore, the rejection should be withdrawn, Applicant is directed to the above arguments.

For at least the reasons above, the 35 USC 103(a) rejection of claim 4 is maintained.

As to Applicant's argument that the combination of Noguchi and Green fails to teach the claim limitations of claims 7-12 and therefore, the rejection should be withdrawn, Applicant is directed to the above arguments.

For at least the reasons above, the 35 USC 103(a) rejection of claims 7-12 is maintained. It is assumed that the reference to claims 7-20 is a typo.

Response to Amendment

In light of Applicant's amendment, the previous claim objections to claims 8-10 are withdrawn.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 2, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,715,169 to Noguchi in view of US Patent No. 6,114,836 to Hagiwara et al. (hereto referred to as Hagiwara) in further view of International Patent Application No. WO 99/00863 to deMuro.

As to claim 2, Noguchi teaches:

- a. An accumulation unit accumulating power (column 5, lines 62-65).

- b. A discharge unit causing discharge of said accumulation unit (time expiration unit) (column 5, lines 41-45).
- c. A measurement unit measuring voltage of said accumulation unit (power source monitor) (column 10, lines 3-10).
- d. said accumulation unit is chargeable by being connected to a power supply apparatus that supplies power to said accumulation unit (column 6, lines 1-5).

Noguchi does not expressly mention controlling access to content through voltage measurement. However, in an analogous art, Hagiwara teaches:

- e. A control unit controlling reproduction of said content based on a value of voltage measured by said measurement unit (a power source controller that uses a discharger and voltmeter to manage and monitor the battery unit for a portable electronic apparatus) (Hagiwara, column 9, lines 15-20).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the game rental cartridge of Noguchi with the discharger and voltmeter of Hagiwara in order to control the operation of the electronic apparatus and prevent loss of data due to power outages as suggested by Hagiwara (Hagiwara, column 1, lines 45-65).

Noguchi as modified does not expressly mention authentication of the battery charging apparatus before recharging the battery. However, in an analogous art, deMuro teaches:

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f. A charge key storage unit storing a charge key unique to the recording media (unique information stored in a memory that authenticates the charging of the battery which is part of the rental game cartridge of Noguchi) (deMuro, page 3, lines 11-27).

g. Said control unit comprises an authentication unit conducting authentication of said power supply apparatus using said charge key unique to the recording medium, and a charge permit unit permitting charging of said accumulation unit when authentication at said authentication unit is successful (deMuro, page 3, lines 11-27).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the rental game cartridge of Noguchi as modified with the authentication method of deMuro in order to safely charge a rechargeable battery as suggested by deMuro (deMuro, page 1, lines 8-32).

As to claim 5, Noguchi as modified teaches:

- a. A control unit controlling charging of the accumulation unit of said recording medium (Noguchi, column 3, lines 31-35 and column 4, lines 36-41)
- b. An usage expiration term set unit setting a usage expiration term of content recorded in said recording medium (setting a counter in said software rental cartridge that stores the length of the rental contract) (Noguchi, column 4, line 66-column 5, line 8).

As to claim 6, Noguchi as modified teaches:

- a. A modify unit modifying an amount of discharge at a discharge unit of said recording medium (switching from battery power to AC power upon detection of low battery voltage) (Hagiwara, column 12, lines 33-39).
- b. a set unit setting a usage expiration term of the content recorded into said recording medium (setting a counter in said software rental cartridge that stores the length of the rental contract) (Noguchi, column 4, line 66-column 5, line 8).

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,715,169 to Noguchi in view of US Patent No. 6,114,836 to Hagiwara et al. (hereto referred to as Hagiwara) in further view of International Patent Application No. WO 99/00863 to deMuro as applied to claim 2 above, and further in view of US Patent No. 5,768,382 to Schneier et al. (hereinafter Schneier).

As to claim 4, Noguchi as modified does not expressly mention the use of a one-time authentication code. However, in an analogous art, Schneier teaches an authentication unit erases said charge key when said authentication is successful ("one-time usage, i.e., an authenticatable start message may only be used once") (Schneier, column 47, lines 49-50).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the game rental cartridge of Noguchi as modified with the one-time authentication method of Schneier in order to ensure the

validity of the scores from a computerized test or game as suggested by Schneier (Schneier, column 1, lines 9-35).

6. Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,715,169 to Noguchi in view of US Patent No. 6,114,836 to Hagiwara et al. (hereto referred to as Hagiwara) in further view of International Patent Application No. WO 99/00863 to deMuro as applied to claim 2 above, and further in view of US Patent No. 4,769,765 to Green.

Note: In the previous Office Action, references to Hagiwara and deMuro were inadvertently omitted from the Header.

As to claim 7, Noguchi as modified does not expressly mention the cutting off the power to the cartridge to make it the content inaccessible after the rental term has expired. However, in an analogous art, Green teaches a control unit of said recording medium to alter a voltage value of the accumulation unit controlling reproduction of content, whereby a usage expiration term of the content recorded in said recording medium is set (disabling a device through the interruption of the power supply once a rental term has expired) (Green, column 2, lines 30-56).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the game rental cartridge of Noguchi as

modified with the power supply interruption of Green in order to control the use of rented equipment as suggested by Green (Green, column 2, lines 10-26).

As to claim 8, Noguchi as modified teaches a control unit that includes a predetermined voltage set unit setting a first voltage value charged at said accumulation unit, and a predetermined second voltage value that disables reproduction of said content, wherein reproduction of said content is controlled based on said first and second voltage values (the invention of Green allows for normal operation of equipment during the rental contract. Once the contract has expired, the voltage is changed to zero so that the equipment will no longer function.) (Green, column 2, lines 30-56).

As to claim 9, Noguchi as modified teaches a voltage set unit alters said first voltage value (power supply line is interrupted resulting in a voltage of zero) (Green, column 2, lines 30-43).

As to claim 10, Noguchi as modified teaches voltage set unit alters said second voltage value (power supply line is connected to supply voltage to make the equipment usable) (Green, column 3, lines 46-54).

As to claim 11, Noguchi as modified teaches a discharge amount control unit controlling an amount of discharge of said discharge unit the use of a power source

controller that controls the charging and discharging of the battery in order to detect the low-battery state (Hagiwara, column 8, lines 19-22).

As to claim 12, Noguchi as modified teaches an accumulation unit that is a secondary battery (Noguchi, column 5, lines 62-67).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William S. Powers whose telephone number is 751 272 8573. The examiner can normally be reached on m-f 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis-Jacques can be reached on 571 272 6962. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William S. Powers
Examiner
Art Unit 2134


8/22/2006

751-272-6962
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